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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,301	09/26/2001	Myron K. Gordin	P04278US5	1091
22885	7590	03/07/2006	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C.			YIP, WINNIE S	
801 GRAND AVENUE			ART UNIT	
SUITE 3200			PAPER NUMBER	
DES MOINES, IA 50309-2721			3636	

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/964,301

Applicant(s)

GORDIN ET AL.

Examiner

Winnie Yip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Part II DETAILED ACTION***

This office action is response to applicant's amendment filed on December 28, 2005.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 20, 22, 29, 32-42 are depended up an allowable product. Pursuant to the procedures set forth in MPEP § 821.04(B), claims 20, 22, 29, 32-42, directed to an allowable product and process of making an allowable product, previously withdrawn from consideration as a result of a restriction requirement, claims 20, 22, 29, and 32-42 hereby rejoined and fully examined for patentability under 37 CFR 1.104.

***Claim Rejections - 35 USC § 112***

1. Claims 1, 7, 9, 20, 21, 29, 32-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 7 and 21, the phrases “a taper of about 0.12 to 0.16 inch per foot” (claims 1 and 21) and “is tapered at 0.14 inches across the diameter of the base per foot in height” (claim 7) are not clear as how to determine the ratio of the taper with respect to what elements. Is it increasing or decreasing in diameter per foot?

Further, regarding claim 21, the language “forming an upper section in a base comprising a single, elongate piece a length of greater than about 8 feet” (lines 3-4) is confusing whether it recites the upper section of base having a single piece and a length of greater than about 8 feet or a base having a single piece and a length of greater than 8 feet? And, the phrase “and having a taper of about ...” (line 7) is confusing as whether or not it is referring to “a lower section” of the

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base. And, the language “forming a bottom portion ....comprising a substantial portion of a length of around 30 feet or greater” (lines 10-11) is confusing whether or not only the bottom portion of the pole having a length of around 30 feet or greater? The claim is generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be replete with grammatical and idiomatic errors. Appropriate correction is required.

Regarding claims 9, 20, 29, 32-42, the terms “the base means” and “pole section means” lack a same terminology with the term “a base” and “a pole” as previously recited. It will cause the claims indefinite. Appropriate correction is required.

Further, regarding claim 9, the term “the means for positioning” lacks a proper antecedent basis and is not previously defined. Appropriate correction is required.

Further, regarding claim 29, the terms “a first pole section”, “any further pole section”, and “one or more pole section” do not consistent the body of the claimed invention as previous recited in claim 21. There is only “a pole” and no “one or more pole sections” previously recited in claim 21. Appropriate correction is required.

Further, regarding claim 31, line 5, the term “a pole” should read “the pole” since it has been previously defined.

### ***Claim Rejections - 35 USC § 102***

2. Claim 43 -45 are rejected under 35 U.S.C. 102(b) as being anticipated by Okuto et al. ‘498.

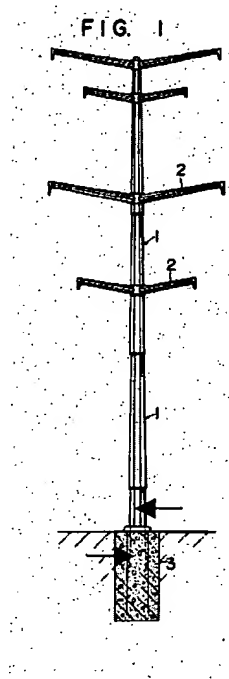
Okuto et al. teach a system for rigidly elevating an array of light fixture structure mounted on one or more cross arms in an elevated position comprising: a unitary base being

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constructed to include a lower section and an upper section, wherein the lower section of the base has a substantial circular cross-section as pre-selected after pre-determination, and the upper section has a taper length and an octagonal configuration as pre-determined and selected, a pole including a plurality of pole sections (1) each being made of hollow metal sheet and having a lower open end, the pole sections are considered to have structural characteristic different from the base, each of the pole section (1) having total length about 45 meters being greater than the length of the base, each of the pole section being tapered along its entire length and each being slip fitted one over and other by the weight of the pole sections to form a single extended pole which inherently have a length greater than the length of the base (3), wherein each pole section being pre-determined and selected with a suitable configuration with specific length, diameters, and thickness (see Table shown in column 4), at least one or more cross arms (2) are mounted on the upper sections of the pole inherently by a connection member for carrying array of electrical elements such as conductors for transmitting high voltage currents and light fixtures, wherein a lower portion (3'') of the base being inserted into a pre-excavated hole in the ground at the site and secured in the foundation (3)(see lines 46-50, 60-63), and the upper portion (1'') extended above the ground, during the assembling operation, a sealant (12) is applied between the lower end of each pole section and the upper end of the lower pole section or to the upper section of the base for locking sections together to form a single pole at least 30 feet as claimed, and the locked pole section is raised into vertical position by means of lifting machine and an oil pressure jack (see col. 3, line 42), the lowest pole section is slip-fitted onto the upper portion of the base capably about one foot above the ground.

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Regard to claim 43, notice the method steps “determining the structural requirements” and “selecting a configuration ...” do not recite any active, positive structure and steps involve in the process that determine what is the structural limitation and method step of the pole and base to be selected. Therefore, the structural limitations including size, weight, configuration of the pole and base broadly read on the prior art references as a matter of design practice and give no patentability weight.



***Claim Rejections - 35 USC § 103***

3. Claims 43-45 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over Centrecon, Inc. (applicant 's prior art as shown in Figure 2) in view of Okuto et al. '498.

Centrecon, Inc., shows and teaches, a “steel and concrete combination lighting pole” for sports lighting applications (see module “SPRORTSLINER II-50 or prior art Fig. 2) being constructed to comprise: a concrete base (30) having a cylindrical lower section (32) being

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inserted into the ground and an tapered upper section (36) being extended above from the ground, the lower section (32) being placed into a ground hole which is filled with concrete thereafter, a pole (34) having a length greater than 30 feet and being made of metal to forms a structural characteristic different from the concrete base, the pole having a hollow lower open end including an interior bore, said interior bore extending axially and inwardly from the lower open end and having a generally tapered inside diameter being slip-fitting over at least a portion of the tapered upper section of the base, the pole being tapered along its entire length and having an elongated frusto-conical shape, wherein the matching portions of the tapered interior bore of pole and the tapered upper section of the base providing "slip-fitting" for positioning the pole onto the base above the ground, wherein the base includes reinforcing means inherently providing suitable strength, height, and weight for supporting the pole in a vertical position, an upper section of the pole having a plurality of cross arms (18, 20) mounted on an upper end of the pole inherently by a connection member, an array of pre-aimed light fixtures (22) being mounted on the cross arms as claimed, and the lower end of pole being locked to the base by any fasteners. Although Centrecon (or the prior art Fig. 2) does not show the pole structure having the length of the pole being substantially longer then the length of the base and the pole being positioned its lower open end of the pole section generally "sever feet" near the ground such as claimed, to determine the distance of how "near" the pole is positioned above the ground would have been obvious matter of design choice as depend upon the constructions of the pole and the base to be selected. Further, Okuto et al. teaches a pole structure comprising a base having an upper section (1") extending above the ground, and a pole having a lower end of the lower section (1) fitting onto the upper section (1") of the base above the ground but near the

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ground. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Lighting Pole of Centrecon (the prior art of the applicant's Figure 2) having the base with the upper section having a preselected length such as shorter than the length of the pole, and pole having predetermined diameter for stacking the pole slip-fitting over the upper portion of the base with the lower end above the ground with equal well distance which "near" the ground as taught by Okuto et al. for easily mounting and elevating the pole in an elevated position.

***Allowable Subject Matter***

4. Claims 1-42 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Response to Arguments***

5. Applicant's arguments filed December 28, 2005 with respect to claims 1 and 21 under U.S.C. 102/103, and specifically to the features of specific dimensions to the base and pole have been fully considered. These features were not specifically and previously claimed in claims. Therefore, this argument is deemed to be persuasive and the rejections are withdrawn.

However, claims 43-45 do not define the specific limitations, and applicant fails to specifically point what variety of limitations are not taught by the references. Especially, claim 43 only recites the pole being constructed to have a lower end and an upper end, and the base has a lower section and an upper section without reciting any specific structural limitation or configuration. Claims 43-45 appears broadly read on the reference to Okuto et al. as discussed set forth above new ground of rejections.



In response to applicant's argument that there is no suggestion to combine the references of the module of Centrecon, Inc. with Okuto et al., the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Centrecon, Inc and Okuto et al. teaches constructing of a lighting pole comprising a tapered pole and a base with a slip fitting processing. Okuto et al. is used as a teaching reference to teach a lighting pole structure comprising a base having an upper section (1") extending above the ground, and a pole being a slip fitting over the upper section of the base with the lower end of the lower section (1) of the pole being maintained above the ground but "nearer" the ground. One ordinary skill in the art would have been obvious to modify the module of Centrecon, Inc. with a base and a pole being configured and determined, as the step of claimed invention, to slip fit the pole over the base in a position that over but near the ground as taught by Okuto et al. for supporting and easily erecting or exchanging the pole in an upright position above the ground. Whether or not the base and the pole of the pole structure of Okuto et al. made of metal is not irrelevant and overcome the prior art of record.

Therefore, the rejection still granted.

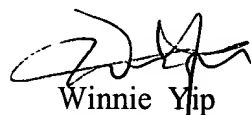
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***Inquiry Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 571-272-6870. The examiner can normally be reached on M-F (9:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Winnie Yip  
Primary Examiner  
Art Unit 3636

wsy  
March 3, 2006